

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GUENTHER UHLENHUTH and MARTIN LOCZENSKI

Appeal No. 2001-0560
Application No. 08/603,719

ON BRIEF

Before McQUADE, NASE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 50, 54-84 and 99-103. No other claims remain pending in this application, claims 85-96 having been canceled subsequent to the final rejection (Paper Nos. 17 and 20).

BACKGROUND

The appellants' invention relates to a method for the longitudinal application of an elongated retainer element onto a traversing traveling or moving bundle having a plurality of electrical and/or optical transmission elements (specification, page 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The examiner relied upon the following prior art references of record in rejecting the appealed claims:

Jore et al. (Jore)	3,405,443	Oct. 15, 1968
Heymann et al. (Heymann)	256,881	May 25, 1988 ¹
(German patent document)		

The following rejection is before us for review.

Claims 50, 54-84 and 99-103 stand rejected under 35 U.S.C. § 103 as being unpatentable over Heymann in view of Jore.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the final rejection and answer (Paper Nos. 16 and 22) for the examiner's complete reasoning

¹ We derive our understanding of this reference from the translation prepared by the PTO, a copy of which is appended to this decision.

in support of the rejection and to the brief and reply brief (Paper Nos. 21 and 23) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Each of claims 99 and 100, the only independent claims on appeal, recites, *inter alia*, a step of "continuously supplying a plurality of [at least two (claim 100)] elongated retainer elements" to said continuously moving bundle. Appellants argue on page 4 of their brief that Heymann provides no teaching or suggestion to use more than one retaining element, as recited in appellants' claims. Indeed, Heymann discloses a method of stabilizing a round composite of linear structures 1 (polyamide ropes) between paired guide rollers 3 and 4 with the aid of a mesh structure (translation, page 7) and further teaches that the mesh structure consists of only one thread

(translation, pages 5 and 8). Based on this disclosure, we share appellants' view that Heymann fails to teach or suggest the use of more than one retaining element. Referring to Exhibit A attached to the answer, the examiner characterizes several portions of the mesh structure as six retaining elements (answer, page 5), but has not provided any evidence or explanation to support the position that these portions of the mesh are separate elements, rather than simply parts of a single thread, as the written disclosure of Heymann seems to indicate.

Jore discloses a method of wrapping a cable 19 with an open helical winding 21 of binder ribbon. However, like Heymann, Jore neither teaches nor suggests continuously supplying more than one elongated retainer element to a continuously moving bundle as required by claims 99 and 100 on appeal. It follows then that the combined teachings of Heymann and Jore are insufficient to establish a *prima facie* case of obviousness of the subject matter of claims 99 and 100 within the meaning of 35 U.S.C. § 103.²

² It is elementary that to support an obviousness rejection, all of the claim limitations must be taught or suggested by the prior art applied (see In re Royka, 490 F.2d 981, 984-85, 180 USPQ 580, 582-83 (CCPA 1974)) and that all
(continued...)

For the foregoing reasons, we shall not sustain the examiner's rejection of claims 99 and 100 or of claims 50³, 54-84 and 101-103 which depend from claims 99 and 100.

²(...continued)
words in a claim must be considered in judging the patentability of that claim against the prior art (In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)).

³ On page 1 of the brief, appellants request that claim 50, which depends from canceled claim 49, be amended to depend from claim 100. Although appellants have not filed a proper amendment changing the dependency of claim 50, for purposes of this appeal, we shall treat claim 50 as depending from claim 100. Upon return of this application to the primary examiner, the examiner should take appropriate action to ensure that such an amendment is made.

CONCLUSION

To summarize, the decision of the examiner to reject
claims 50, 54-84 and 99-103 under 35 U.S.C. § 103 is reversed.

REVERSED

JOHN P. McQUADE)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JENNIFER D. BAHR)	
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